

REMARKS/ARGUMENTS

Claims 1-18 and 28-46 are pending in the instant patent application. Claims 1, 28, and newly added Claim 46 are the three (3) independent claims. Claims 2 through 18 depend from Claim 1. Claims 19 through 27 were canceled from the application. Claims 29 through 45 depend from independent Claim 28.

I. Election

On or about December 21, 2005, Applicants, pursuant to a restriction requirement, elected without traverse Group I or Claims 1 through 18. Applicants also added new Claims 28 through 45 drawn to the elected invention that read on the elected Group. In the election, Claims 19 through 27 were canceled from the application.

II. Objection to Specification

In the Action, the specification was objected to as "the cross reference to related patent applications" section of the patent application, although technically accurate, did not reflect the most current status of the related patent applications. Applicants have amended the specification to overcome this minor informality. Reconsideration and withdrawal of the objection are requested.

III. Petition Decision of September 26, 2005

On or about September 26, 2005, the Office accepted and granted the petition filed on July 12, 2004 to accept an unintentionally delayed claim for the benefit of the prior-filed applications set forth in the previously filed amendment.

The Office held that since the petition satisfied the requirements under 37 C.F.R. § 1.78(a)(3) and (a)(6) for acceptance of an unintentionally delayed priority claim under 35 U.S.C. § 120 and 119(e), the petition to accept the unintentionally delayed claim or benefit to a prior-filed non-provisional patent application No. 09/408,944 and provisional patent application No. 60/105,417 is granted.

The Applicants have noted the same in the amendments to the specification listed above and state that since this application is entitled to the benefits listed under the page 2 of the petition decision, the Applicants state herein that the Applicants are entitled to the priority claim to the date of October 23, 1998, as noted on the Corrected Official Filing Receipt.

IV. Claim Rejections under 35 U.S.C. § 102(b)

United States Patent No. 5,836,943 to Miller, et al.

In the Action, Claims 1-13, 16-18, 28-40, and 43-45 were rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,836,943 to Miller, III (hereinafter "Miller"). Applicants respectfully submit that Miller does not disclose or suggest all of the elements in independent Claims 1 and 28.

Claim 1 recites a method for electrosurgically sealing tissue. The method has the step of applying a first pulse of RF energy to the tissue. The method also has the step of applying at least one subsequent RF energy pulse to the tissue and keeping constant or varying RF energy parameters of individual pulses of subsequent RF energy pulses in accordance with at least one characteristic of an electrical transient. The electrical transient occurs during the individual RF energy pulses.

Miller discloses an electrosurgical generator capable of applying a first pulse of RF energy to tissue and subsequent RF energy pulses in accordance with measured impedance during the application of the first and subsequent RF energy pulses. (See Miller at col. 12, line 50 to col. 13, line 37 and FIG. 9). This method of Miller of operating an electrosurgical generator, as well as other electrosurgical instruments, is widely known in the art. It is generally referred to as "impedance feedback monitoring".

Applicants, on the other hand, have realized a method for electrosurgically sealing tissue that does not rely exclusively on impedance feedback monitoring.

Applicants' method keeps constant or varies RF energy parameters of subsequent individual RF energy pulses in accordance with at least one characteristic of an electrical transient that occur during the individual RF energy pulses, as recited by Applicants' Claim 1. This is not the "impedance feedback monitoring" as disclosed in Miller. Therefore, it is believed that Claim 1 is patentably distinct over the disclosure and teachings of Miller. Accordingly, withdrawal of the rejection with respect to Claim 1 under 35 U.S.C. §102(b) over Miller and allowance thereof are respectfully requested.

Claims 2-13 and 16-18 depend from independent Claim 1 and are patentable for at least the same reasons as discussed above.

Independent Claim 28 is patentable for reasons analogous to those argued above for Claim 1. In addition, Claims 29-40 and 43-45 are also patentable as these claims depend from allowable independent Claim 28. Accordingly, withdrawal of the rejection with respect to these Claims under 35 U.S.C. §102(b) over Miller and allowance thereof are respectfully requested.

V. Claim Rejections under 35 U.S.C. § 103(a)

Miller in view of United States Patent No. 5,558,671 to Yates

In the Action, Claims 14, 15, 41, and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of United States Patent No. 5,558,671 to Yates, et al. (hereinafter "Yates"). Applicants respectfully traverse these rejections on the grounds that Miller, Yates, and the combination thereof do not disclose or suggest all of the limitations of the rejected claims.

Claims 14 and 15 depend from Claim 1, and Claims 41 and 42 depend from Claim 28. As discussed previously, with respect to the rejection of Claim 1, Miller simply fails to disclose or suggest a method for electrosurgically sealing tissue which keeps constant or varies RF energy parameters of subsequent individual RF energy

pulses in accordance with at least one characteristic of an electrical transient that occurs during the individual RF energy pulses, as recited by Applicants' Claim 1.

Yates does not cure the deficiencies of Miller. Yates discloses use of lookup tables in conjunction with measured impedance for performing impedance feedback monitoring during electrosurgery. Yates does not disclose or suggest a method for electrosurgically sealing tissue which keeps constant or varies RF energy parameters of subsequent individual RF energy pulses in accordance with at least one characteristic of an electrical transient that occurs during the individual RF energy pulse as recited by Applicants' Claim 1. Thus, in addition to depending from allowable independent Claim 1, Claims 14 and 15 are also allowable for these additional reasons. Accordingly, withdrawal of the rejection with respect to Claims 14 and 15 under 35 U.S.C. §103(a) over Miller, in view of Yates and allowance thereof are respectfully requested.

With regard to the rejection of Claims 41 and 42, which depend from independent Claim 28, Miller, Yates and the combination thereof also do not disclose or suggest any means for applying at least one subsequent RF energy pulse to the tissue and keeping constant or varying RF energy parameters of individual pulses in accordance with at least one characteristic of an electrical transient that occurs during the individual RF energy pulses.

Miller discloses an electrosurgical generator. The generator of Miller is capable of applying a first pulse of RF energy to tissue and then applying subsequent RF energy pulses in accordance with measured impedance during the application of the first and subsequent RF energy pulses. (See Miller at col. 12, line 50 to col. 13, line 37 and FIG. 9). Yates discloses performing impedance feedback monitoring during electrosurgery.

Thus, in addition to depending from allowable independent Claim 28, Claims 41 and 42 are also allowable for these additional reasons. Accordingly, withdrawal of the rejection with respect to Claims 41 and 42 under 35 U.S.C. §103(a) over Miller, in view of Yates and allowance thereof are respectfully requested.

VI. Newly added Claim 46

Claim 46 is patentable over the relied upon references. Claim 46 provides for a method for electrosurgically sealing tissue. The method has the steps of applying a first pulse of RF energy to the tissue and applying at least one subsequent RF energy pulse to the tissue and keeping constant or varying RF energy parameters of individual pulses of subsequent RF energy pulses in accordance with at least one characteristic of an electrical transient that occurs during the individual RF energy pulses. Claim 46 also provides that the at least one characteristic that controls the variation of the pulse parameters is a width of the electrical transient and the width occurring at an initial phase or beginning of each subsequent RF energy pulse. None of the cited and relied upon references disclose or suggest new Claim 46. Allowance of claim 46 is earnestly solicited.

VII. Rejection of Claims 1 through 18, and 28 through 45 Under Doctrine of Obviousness-type Double Patenting

Claims 1-18 and 28-45 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 23 through 52 of U.S. Patent No. 6,398,779, which is commonly owned by the instant Applicants. A terminal disclaimer is filed concurrently with this amendment. The terminal disclaimer is proper to traverse the rejection since the present application and U.S. Patent Nos. 6,398,779 are commonly owned.

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. Such early and favorable action is earnestly solicited.

Should the Examiner believe that a telephone interview may facilitate prosecution of this application, the Examiner is respectfully requested to telephone Applicant's undersigned representative at the number indicated below.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550.

Respectfully submitted,



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